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Karl Lang

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STANDLEY LAW GROUP LLP
495 METRO PLACE SOUTH
SUITE 210
DUBLIN, OH 43017

EXAMINER

WRIGHT, PATRICIA KATHRYN

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/765,112	Applicant(s) LANG, KARL	
	Examiner P. KATHRYN WRIGHT	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-29 and 35-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-29 and 35-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Claims

1. This action is in response to papers filed December 04, 2007 in which claims 35-36 were amended. The amendments have been thoroughly reviewed and entered. Any objection/rejection not repeated herein has been withdrawn by the Office.

Claims 2-29 and 35-39 are under prosecution.

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: at least two receptacles (claim 35). The Office recommends that Applicant change at least two receptacles to --receiving holes—or --apertures-- since the word "receptacle" was not disclosed in the specification as originally filed.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 2-29, and 35-38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably

convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 35 now recites an "instrument holder comprising a holder device with at least two receptacles, each receptacle arranged to receive and hold one of the at least two instruments."

The "at least two receptacles" do not appear to find support in the specification as originally filed. At page 8, line 20, the specification does describe "the opening 6 of the instrument holder 5 is designed to receive a cup-shaped holder ring 15 with a knob handle 23 at the center. The holder ring 15 has receiving holes 16 for holding various elongated instruments such as, in the illustrated case, eight 25 tubes 17, but the elongated instruments could also be pipettes or measuring electrodes". There is no support for the broader recitation of "receptacles".

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 2-29 and 35-38 remain rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent no. 3,552,212 to Ohlin in view of US Patent 5,650,122 to Harris et al., (hereinafter Harris).

Ohlin discloses a device for cleaning the exterior of instruments, such as transfer devices. The device comprises an instrument holder (22) including a holder device (reads on ring; no reference No. in Figs 1-2). The instrument holder is connected to a

vertical post (23) on a housing (11). The ring surrounds the transfer instrument entirely. The vertical post is mounted for axial reciprocation and rotation. A washing device (24) is provided to wash the transfer instruments. The washing device is located vertically below the transfer instruments. The washing device contains a passageway (34), through which wash fluid flows into a recess (31) where the transfer instruments are contacted with the wash fluid. The washing device is separate from the instrument holder.

With respect to the wash device (24) being movable relative to the instruments being cleaned, Ohlin teaches that the collar of the wash device need not be stationary while the body to be cleaned is displaceable, but the collar may move while the instrument being cleaned is stationary (col. 3, lines 51-53). Thus, the wash device may be movable in relation to the instrument being cleaned. Presumably, a drive mechanism allows the instrument and/or wash device to be movable. The housing (11) serves as a constraint to limit the movement of the vertical post. See figures 1-3.

Ohlin differs from the instantly claimed invention in that there is no disclosure of a jet orifice that sprays wash fluid at the instruments that are to be cleaned or the holder element with at least two receptacles.

Harris teaches an analysis instrument having a wash manifold (486) for washing aspiration tubes. The wash manifold is charged with a high pressure stream (jet stream) of wash solution by a pump. The wash manifold has multiple wash tubes (484), each of the wash tubes having a fluid outlet/orifice (488) to direct wash solution at the aspiration tubes. The tubes Harris further teaches that the fluid outlets are angled

toward the aspiration tube at an angle of about 15 degrees, as recited in claims 8, 9, 15, 16 and 17. Harris teaches that the diameter of the outlet is 0.027 inch (0.68 mm), as recited in claims 12-14. Further, Harris teaches that in spraying the wash solution, an agitated scrubbing action is provided and the time required to conduct the wash cycle is reduced. See col. 15, lines 26-45.

Thus, it would have been obvious to one of ordinary skill in the art to include in the device of Ohlin the use jet orifices directed at an angle, as taught by Harris, to enhance the washing process (because of the scrubbing action provided by spraying) and thus reduce the time needed to completely wash the instruments. Furthermore, it would have been obvious to one of ordinary skill in the art to use multiple jets to assure that the entire instrument is cleaned.

With respect to the claim recitation that the instrument holder including a holder having at least two receptacles (receiving holes), each receptacle arranged to receive and hold an instrument, one of ordinary skill in the art would recognize that more than one instrument could fit into the receptacle holder of Ohlin; thus, it would be obvious to include in Ohlin a holder with at least two receptacles since the ordinary artisan would expect that this would increase instrument washing throughput. Furthermore, the court has held that mere duplication of parts (i.e., more than one receptacle) has no patentable significance unless a new and unexpected result is produced. See MPEP 2144.04 and *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

7. Claims 2-29, 35, and 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent no. 4,338,280 to Ambers et al. (hereinafter "Ambers").

Ambers discloses a device for cleaning the exterior of instruments (24). The device comprises an instrument holder (108) having a removable holder device (130) with a single receptacle (132; Fig. 4). Note that "receptacle" has been interpreted by the Office to mean "aperture" or "receiving holes". The instrument holder is connected to a vertical post (106) on a housing (100). The ring surrounds the transfer instrument entirely. The vertical post is mounted for axial reciprocation and rotation.

Ambers teaches a washing device (50) designed to wash the instruments in the instrument holder. The washing device has a central opening (180) located vertically below the instrument holder. The washing device includes a plurality of diametrically opposed jet orifices (182, 184; Fig. 5) and passageways (188, 192), through which wash fluid flows into a recess (186) where the transfer instrument 24 are contacted with the wash fluid. The washing device is separate and moveable from the instrument holder.

The wash device may be movable in relation to the instrument being cleaned. A drive mechanism (72, 74) allows the instrument to be movable relative to the wash device (col. 3, lines 64+). The housing (100) serves as a constraint to limit the movement of the vertical post. See figure 2. The fluid jet orifices are angled toward the aspiration tube at an angle of about 25 degrees, as recited in claims 8, 9, 15, 16 and 17.

Ambers differs from the instantly claimed invention in that there is no disclosure of the holder element having at least two receptacles (apertures), each for holding an instrument.

However, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to include in the device of Amber at least two receptacles in the holder element, since the ordinary artisan would recognize that this would increase washing throughput. Furthermore, the court has held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced. See MPEP 2144.04 and *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

Response to Arguments

8. Applicant's arguments filed December 04, 2007 have been fully considered but they are not persuasive.

In response to the previous objection to the specification disclosing the term "receptacle", Applicant argues that Figure 2 and page 13, second full paragraph shows eight "receiving holes".

The Examiner does not agree that the "receiving holes" provide support for the "receptacles" as currently claimed. Nor has Applicant clearly illustrated where the term "receptacles" finds support in the specification as originally filed. Page 8, line 20 of the specification describes "the opening 6 of the instrument holder 5 is designed to receive a cup-shaped holder ring 15 with a knob handle 23 at the center. The holder ring 15 has receiving holes 16 for holding various elongated instruments such as, in the illustrated

case, eight 25 tubes 17, but the elongated instruments could also be pipettes or measuring electrodes". There is no support for the broader recitation of "receptacles". The Office recommends that Applicant change at least two receptacles to --receiving holes-- or --apertures-- since the word "receptacle" was not disclosed in the specification as originally filed.

In response to the previous rejection of claims 1-29 over Ohlin in view of Harris, Applicant alleges that Ohlin '212 teaches no embodiment with a holder element having at least two receptacles, each receptacle arranged to receive and hold one of the two instruments. Applicant again argues that the lower probe portion 19 in Ohlin passes through the bore to create an "annular space" with the walls of the bore. Applicant argues that this annular space can only be created when the when a single instrument is passed through central opening. Applicant concludes that Ohlin does not teach an embodiment where the space is not annular.

Respectfully, the Office does not agree with Applicant. The Examiner contends that shape of the space between the instrument and the wash ring in Ohlin is not germane to the argument. The invention as currently claimed does not define the space between the instrument and the wash ring. Furthermore, Ohlin not teach away from wash ring surrounding at least two instruments (i.e., probes) because the Ohlin disclosure does not criticize, discredit, or otherwise discourage the wash ring from surrounding at least two probes. See *In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004) and MPEP 2123. Furthermore, Ohlin does not set forth a particular range for the annular space. Ohlin states that the shape of the bore 26 in the

wash ring and the relative dimensions bore 26 and the probe portion 19 to be cleaned are not critical, see col. 3 lines 33+. (Emphasis added.) Thus, it is possible for the Ohlin wash ring to simultaneously surround and wash a plurality of smaller probes, like the 18-gauge needles taught in Harris, and spray wash fluid at the instruments, as recited in the instant claims. Accordingly, it would be obvious to include in Ohlin a holder with at least two receptacles to hold multiple probes since the ordinary artisan would expect that this would increase instrument washing throughput. The court has held that mere duplication of parts (i.e., more than one receptacle) has no patentable significance unless a new and unexpected result is produced. See MPEP 2144.04 and *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

For the reasons delineated above, Applicant has failed to demonstrate that the washing device of Ohlin is not capable of surrounding at least two probes or that it would be rendered inoperable for its intended purpose (i.e., washing). Thus, the rejection of the instant claims is maintained.

Regarding the previous rejection of claims 2-29, 35-38 under 35 U.S.C. 103(a) as being unpatentable over US Patent no. 4,338,280 to Ambers, Applicant argues that the through passage 132 in the holding device 130 (wiper grommet) of Ambers “receives” but does not “hold” the (instrument) tube 24, as currently claimed.

The Examiner respectfully disagrees with Applicant’s assertion. The word “hold” can be defined “to enclose and keep within bounds”. Clearly, the passage 132 encloses and keeps the instrument 24 within bounds. Furthermore, nothing the claim requires that the receptacles are the only means used to grip the

instrument during washing. Thus, the holding device 130 (wiper grommet) of Amber receives and holds the instrument tube, as currently claimed.

Furthermore, Applicant argues that orifices 182, 184 in the washing device 50 are not intended for washing the tube, as orifices are directed at the spherical surface 136 and socket portion 148 of the holding device (wiper grommet 130), not the tube.

Again the Examiner respectfully disagrees with Applicant's assertion. Claim 37 recites the jet orifice is aimed radially inward to the central opening (of the washing device). The functional recitation describing the spraying of the wash fluid at a portion of the instrument passing through the central opening is merely an intended use which the prior art would inherently be capable of doing. That is the Amber teaches that the jet orifices are aimed radially inward to the central opening (of the washing device), see Fig. 3. Furthermore, the Amber instrument (tube 24) is capable of extending beyond the holder device 130 in aspirate mode of operation (see Figs.8-9). Since the instrument tube 24 is inherently capable of extending into the wash device, the orifices 182, 184 are capable of spraying of the wash fluid at a portion of the instrument 24 that extends beyond the holder device. It is incumbent upon Applicant to show that the application disclosed by the prior art is not actually capable of performing such functions. See *In re Ludtke*, 169 USOQ 563 (CCPA 1971).

Therefore, for the reasons delineated above, rejection of claims 2-29, 35, and 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ambers is maintained.

Conclusion

9. No claims are allowed.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Kathryn Wright whose telephone number is 571-272-2374. The examiner can normally be reached on Thursday, alternate Fridays off.

Art Unit: 1797

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pkw

/Jill A. Warden/

Supervisory Patent Examiner, Art Unit 1797